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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,892	06/29/2001	Hideaki Ono	50195-261	4949

7590 03/06/2003

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EXAMINER

SHEEHAN, JOHN P

ART UNIT	PAPER NUMBER
	7

1742

DATE MAILED: 03/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/893,892	ONO ET AL.
	Examiner	Art Unit
	John P. Sheehan	1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on December 20, 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 and 3 to 13 is/are pending in the application.

4a) Of the above claim(s) 5-12 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1, 3, 4 and 13 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Election/Restrictions***

1. This application contains claims 5 to 12 drawn to an invention nonelected with traverse in Paper No. 3. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Objections***

1. Claim 13 is objected to because of the following informalities:

- I. In claim 13, lines 3 and 4, the term, "magent" appears to be a typographical error.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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I. In claim 13, lines 2 and 3, the meaning of the phrase, "compression-molding under a condition in which crystallization direction are arranged to the constant direction in magnet filed" is not clear. What does this phrase mean?

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1 to 4 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by

Nomura et al. (Nomura, US Patent No. 6,261,385).

Nomura teaches an anisotropic nanocomposite rare earth permanent magnet consisting of a hard magnetic phase and a soft magnetic phase (column 3, lines 28 to 35). Nomura teaches that the hard magnetic phase contains a rare earth metal, a transition metal and nitrogen or boron (column 3, lines 60 to 68) and the soft magnetic phase can contain at least one transition metal and boron or nitrogen (column 4, lines 3 to 8). Nomura teaches that the hard magnetic phase can contain at least one rare earth, a transition metal and N or B (column 4, lines 37 to 43) and that the soft magnetic phase can contain a transition metal and B (column 4, lines 48 to 51). These hard and

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soft magnetic phases taught by Nomura are encompassed by the instant claim language used to claim the hard and soft magnetic phases recited in the instant claims. Nomura defines the crystal size of a nanocomposite as being "several tens of nanometers" (column 2, lines 40 to 45) which overlaps the crystal size range of "150 nm or less" recited in the instant claims. Nomura also teaches preferred combination of phases that are encompassed by the instant claims (column 4, line 60 to column 5, line 3). Nomura teaches that this magnetic material can be ground to form an anisotropic nanocomposite powder (column 8, lines 1 to 5). Finally, Nomura teaches specific example alloys that are encompassed by the instant claims (column 9, Examples 2 to 6).

Applicants' claimed invention does not distinguish over the powder taught by Nomura.

### ***Response to Arguments***

Applicants' arguments submitted December 20, 2002 have been considered by the Examiner but have been found non-persuasive. In addition to the position set forth in the rejection above the Examiner adds the following comments.

Applicants state that Nomura does not teach that the rare content "is from 2 to 15 atomic %, and the content of at least one element selected from the group consisting of boron (B), carbon (C), nitrogen (N) and oxygen (O) is from 1 to 25 atomic %". The Examiner is not persuaded. As set forth above in the statement of the rejection, Nomura teaches specific example alloys having compositions that are encompassed by

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these proportions (Nomura, column 9, Examples 2 to 6). Each of these cited example alloys have rare earth metal and boron proportions that are encompassed by proportions recited in applicants' claims and arguments.

On pages 13 and 14 of their response applicants separately describe their invention and then describe Nomura's alloy. Applicants then conclude that, "As a result, Nomura et al. fail to disclose or teach the claimed ratio of elements" and "that an atomic occupation ratio of elements in amended claim 1 is physically quite different from a volume ratio of phases disclosed by Nomura". The Examiner is not persuaded. Again, as set forth above in the statement of the rejection, Nomura teaches specific example alloys having compositions that are encompassed by the proportions recited in applicants' claims (Nomura, column 9, Examples 2 to 6). With respect to the phase volume ratios taught by Nomura, it is the Examiner's position that applicants' claims are silent in this regard and therefore do not preclude the phase volume ratios taught by Nomura.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

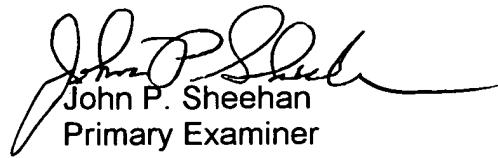
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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
John P. Sheehan  
Primary Examiner  
Art Unit 1742

jps  
March 5, 2003